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/Erin Cowles/  
Erin Cowles

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 09/527,931 Confirmation No. 3919  
Applicant : Mathieu et al.  
Filed : March 17, 2000  
TC/A.U. : 4726  
Examiner : Rick K. Chang

Docket No. : P114-US

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P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

To Whom It May Concern:

For the reasons set forth below, Applicants respectfully file this petition under CFR 1.181 requesting that the finality of the Office Action dated January 8, 2009 be withdrawn.

**I. Statement Of Facts**

An amendment was presented and entered on August 9, 2007.

The PTO issued a final Office Action on October 22, 2007 rejecting all claims as allegedly indefinite under 35 U.S.C. 112. This was the sole grounds of rejection. The Examiner alleged that applicants' amendment had necessitated the new grounds of rejection.

Applicants filed a Pre Appeal Brief Request for review dated November 6, 2007.

The PTO issued a Decision dated December 12, 2007 reopening prosecution.

The PTO issued a final Office Action on March 18, 2008 repeating the rejections under 35 U.S.C. 112 and making new rejections alleging all claims as being obvious under 35 U.S.C. 103 in view of Ardezzone U.S. Patent No. 4,636,722 and Daugherty U.S. Patent No. 5,990,695. The Examiner alleged that applicants' amendment had necessitated the new grounds of rejection.

Applicants filed a second Pre Appeal Brief Request for review Dated September 18, 2008.

The PTO issued a Decision dated October 31, 2008 again reopening prosecution.

The PTO issued a final Office Action on January 8, 2009. The Office Action of March 18, 2008 was withdrawn. The claims were rejected under new grounds as being allegedly either anticipated under 35 U.S.C. 102 or obvious under 35 U.S.C. 103 by Daugherty U.S. Patent No. 5,990,695. The Examiner alleged that applicants' amendment had necessitated the new grounds of rejection.

## **II. Relief Requested**

For the reasons set forth below, Applicants respectfully assert that the January 2009 Office Action should not have been made final. Applicants accordingly request that the finality of the January 2009 Office Action be withdrawn.

## **III. Argument**

### **A. The Office Guidelines**

The Manual of Patent Examining Procedure (M.P.E.P.) sets forth those instances where the Office can impose a final rejection. As set forth in the second paragraph of M.P.E.P. § 706.07(a), the Office can impose a final rejection except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of claims nor based on information submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c). Here, the Examiner has not alleged that prior art cited in an information disclosure statement supports making the January 2009 Office Action final. Moreover, as discussed below, no amendments have been submitted after the October 2007 Office Action which necessitated the numerous changes in the grounds of rejection that occurred in the Office Actions of March 2008 and January 2009.

### **B. The January 2009 Office Action Should Not Have Been Made Final**

The Appeal and the Panel Decisions of October 31, 2008 and December 12, 2007—not the August 2007 amendment—prompted the changes in the grounds of rejection between the August 2007 Office Action and the January 2009 Office Action. As stated in the

Summary Section of the January 2009 Office Action, the January Office Action is responsive to the communications of 9/18/09 (i.e., the Appeal and the Panel Decision)—not to the August 2007 Amendment. Indeed, the fact that the January 2009 Office Action withdrew the March 2008 Office Action makes clear that the new grounds of rejection issued in January 2009 were in response to the Panel Decision of October 2008, and not the August 2007 amendment. Similarly, as stated in the Summary Section of the withdrawn March 2008 Office Action, the March 2008 Office Action was issued in response to the communication of 11/6/2007 (i.e., the Appeal and Panel decision) —not the August 2007 amendment.

#### **IV. Conclusion**

For these reasons, as well as those of record, Applicants respectfully request withdrawal of the finality of the Office Action.

Respectfully submitted,

Date: February 6, 2009

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